

transmittal form that provides a box for a preliminary amendment, applicants are advised not to use such box, but to provide the preliminary amendment on a separate sheet of paper in compliance with revised 37 CFR 1.121.

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B. Claims

B1. May I submit a complete claim listing in a reply when I am not making any changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 14, 2003)

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing in this situation would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

B2. How should I amend a formula in a claim? (posted August 21, 2003)

Applicants may use one of the following methods, for example, change "H4" to "H2" in a chemical formula:

(1) Strikethrough and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H4 (C2O3)2 C6H2 (C2O3)2.

(2) Doublebrackets and underlining the whole formula.

Claim 1 (currently amended) A curing agent for epoxy resins comprising pyromellitic dianhydride, [[C6H4(C2O3)2]]C6H2 (C2O3)2.

(3) Delete the claim and replace it with a new claim.

Claim 1 (canceled).

Claim 2 (new) A curing agent for epoxy resins comprising pyromellitic dianhydride, C6H2 (C2O3)2.

Do not use strikethrough or doublebrackets to delete only subscript "4" and use underlining to add only subscript "2" in the formula.

B3. In the past, I have included claim status that indicates how many times a claim has been amended, i.e., "Claim 1 (Twice Amended)." Is it proper to indicate that a claim has been "previously amended twice" or "currently amended for the third time?" (posted August 21, 2003)

No, under the revised amendment practice, it would NOT be appropriate to indicate how many times a claim has been amended. Only the following seven status identifiers are permitted: "original", "currently amended", "canceled", "new", "withdrawn", "previously presented", and "not entered".

B4. May I submit a complete claim listing in a reply when I am not making any

changes to the claims, such as responding to a restriction requirement or merely arguing a rejection? (posted August 21, 2003)

Yes. Although a complete claim listing is only required whenever changes are made to any claims, one may be submitted in a reply to an Office action where no changes are being made. It is beneficial to the examiner (and all viewers of the electronic file) to have the most up-to-date set of claims in the most recent paper submitted by the applicant. Note that the claim listing would not include any claims with markings or any claims with the status identifiers of (new) or (currently amended).

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C. Drawings

C1. When I file an amendment to the drawings, do I need a Letter to the Office Draftsman? (posted August 14, 2003)

No, a Letter to the Office Draftsman is not required. The amendment to the drawings must include: (1) replacement figures which incorporate the desired changes, and (2) an explanation of the changes either in the drawing amendments or remarks section of the amendment.

C2. My drawings in the application have been objected to by the examiner. Should I submit proposed changes to the drawings in red for the examiner's approval before I submit the final version of the drawings? The attachment for PTO-948 that accompanies an office action entitled "Information on How to Effect Drawing Changes" provides that changes to drawings other than informalities noted by draftsperson requires a sketch with changes to be incorporated marked in red to be submitted. MPEP 608.02(v) also provides changes to be submitted in a similar way.

What procedure should I follow for the following? (posted August 21, 2003)

The proposed drawing correction practice has been discontinued. In order to comply with the revised amendment practice, applicant must submit replacement drawings with the desired changes already incorporated into the figures and label those sheets of drawings as replacement sheets. Changes should be discussed in the remarks section or the Amendment to the Drawings section of your amendment document. Additionally, applicants are permitted to submit (if desired), or the examiner may require, annotated drawings in addition to the replacement sheets if the changes being made are hard to discern or need further explanation. Redline markings are acceptable in annotated drawings. The Office will revise the PTO-948 and the MPEP 608.02(v) in accordance with the revised amendment practice.

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D. Effective Date

D1. If I filed an amendment under the previous version of 37 CFR 1.121 with a certificate of mailing date before July 30, 2003, the effective date of revised 37 CFR 1.121, but the Office received the amendment on or after July 30, 2003, would the amendment be accepted as a compliant amendment under 37 CFR 1.121? (posted August 14, 2003)

Yes, if the amendment is filed in compliance with the previous version of 37

CFR 1.121 with a certificate of mailing date before July 30, 2003, the amendment will be accepted as a compliant amendment. See Pre-OG notice, Amendments Permitted under the Revised Amendment Practice and Treatment of Non-Compliant Amendments (signed July 11, 2003) available on the USPTO website.

D2. I filed an after-final amendment in compliance with the previous version of 37 CFR 1.121 with a certificate of mailing date before July 30, 2003 and the amendment was not entered by the Office. I would like to file a request for continued examination (RCE) under 37 CFR 1.114 and have the after-final amendment to be entered as the submission for the RCE. If the RCE is filed on or after July 30, 2003, would the Office accept the after-final amendment as a compliant amendment when the amendment is entered as the submission for the RCE? (posted August 14, 2003)

Yes, if the after-final amendment is filed in compliance with the previous version of 37 CFR 1.121 with a certificate of mailing date before July 30, 2003, the Office will enter the amendment as a compliant amendment when the RCE is entered.

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E. National Stage Applications

E1. I have canceled a claim and renumbered the other claims during the international stage of an international application that has subsequently entered the national stage. I would like to file a preliminary amendment to the claims in the national stage of the international application, what status identifier(s) should I use for the renumbered claims? (posted August 14, 2003) (revised August 21, 2003)

Assuming that the amendment under Article 19 or 34 made during the international phase is entered in the U.S. national stage application (this will not be the case where, for example, a required English translation of the amendment is not timely furnished), the status identifier, "previously presented", should be used for renumbered claims that are not being amended in the preliminary amendment. The status identifier, "currently amended", should be used for renumbered claims that are being amended in the preliminary amendment.

For example, an applicant filed an international application that originally included independent claim 1, and dependent claims 2, 3 and 4. During the international stage, Claim 1 was amended, claim 3 was canceled, and claim 4 was renumbered as claim 3. If the amendment made during the international phase is entered in the U.S. national stage application, then a preliminary amendment adding two new claims would include a claim listing as follows:

Claim 1 (previously presented)
Claim 2 (original)
Claim 3 (previously presented)
Claim 4 (new)
Claim 5 (new)

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